

REMARKS/ARGUMENTS

Original claims 1-12 and new claims 19-24 remain in the application for examination, claims 13-18 have been withdrawn from further consideration as being drawn to a non-elected invention.

Drawings:

The drawings have been rejected as not showing the expandable foam recited in claim 11. The basis for recitation of claim 11 is paragraph 25. Applicant has added a new figure, Fig. 4B, which shows what is disclosed in paragraph 25 and in original claim 11, by illustrating a cellular structure that has been expanded between the duct and the wall.

The specification has been further amended to change original Fig. 4 to Fig. "4A" and a new paragraph (0027) has been inserted to describe the structure shown in Fig. 4B. The new paragraph (0027) includes the subject matter of originally presented paragraph 25. The paragraph numbers have been adjusted to run consecutively.

Claim Rejections Under 35 U.S.C. §103:

The Examiner's presumption that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made is correct.

Independent claim 6 and dependent claims 8-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over either Pasch et al. DE '847 or Dausch FR '043 in view of any one of Wycech, Emmelmann et al., Schoen et al., Hopton et al., Czaplicki, or Czaplicki et al. while independent claim 1 and dependent claims 4-5 and 7 have been rejected over the same combination of references further in view of Omarain. Applicants respectfully traverse these rejections.

Considering the primary references individually, Pasch et al. De '847, used to reject

independent claim 6, discloses "a cross bearer" (1) which supports an instrument panel (17) attached thereto, wherein air fans (13) (see Figs. 2-4) are inserted therein. The pipes (13) are supported in portions (4) of the cross bearer (1) by a tube (16) that engages the inner wall of the portions (4) of the cross bearer. As the Examiner states, Pasch et al. does not detail "any cellular structure between the duct and frame member wall." Rather, the flexible plastic pipe (flexiblen Kunststoff bestehende Rohrleitung) (13) directly engages the inner wall of the cross bearer (1) with projections (16), which are part of the flexible plastic pipe, as is best seen in Fig. 3 of Pasch et al.

Applicants respectfully submit that Pasch et al. is directed to a "cross-bearer" (1) for supporting an instrument panel (17) that is attached to the cross member rather than to Applicants' claimed "hollow vehicular frame member constructed and arranged to support exterior structure of the vehicle." The Examiner's attention is directed to Applicants' Figs. 1 and 2 which disclose beams and pillars which form the frame of a vehicle rather than structures which support internal components such as a dashboard or instrument panel of an automotive vehicle. The cross member is of light weight construction relative to the rigid load bearing structure of the automobile frame elements claimed in this application. Note that the supports (3) of Pasch et al. are described as "Mittelteil" which means that they are made of light metal. Likewise, the portions (11) are of lightweight construction. Accordingly, the cross member (1) does not provide the substantial rigidity to the automobile frame contributed by structural elements, such as the pillar (12) disclosed by Applicants. Moreover, the pillar (12) disclosed by Applicants is welded, which is clearly not the case with the cross-bearer (1) of Pasch et al. that has to support only the plastic ducts 13 and instrument panel. Clearly, the cross member (1) of Pasch et al. does not correspond to Applicants' claimed beam.

Dausch FR '043 is similarly deficient as a primary reference in that Dausch is also directed to a support for a dashboard or instrument panel. (See Figs. 2 and 3 of Dausch) wherein climate control ducts 3 are inserted into a transverse support 2. Accordingly, there is neither a teaching of nor a suggestion of a hollow vehicular frame member constructed and arranged to support exterior structure of a vehicle (independent claim 6) or of a pillar having a vertically extending section and a horizontally extending section (independent claim 1). Like Pasch et al., Dausch does not in the Examiners words "detail" any cellular structure between the duct and frame member wall." Rather, like Pasch, Dausch supports the duct 3 within the transverse instrument panel support 10 using circumferentially spaced projections 18a and 18b in Figs. 6 and 7 and annular projections 19 in Fig. 8.

There is absolutely no disclosure of the following structure in Pasch et al. or Dausch:

a layer of cellular structure disposed between the duct and the wall, the layer of the cellular structure being adhered to the wall of the hollow vehicle frame member (claim 6).

and

a layer of a cellular structure disposed between the duct an the wall of the pillar, and expandable adhesive between the cellular structure and the wall for bonding the cellular structure to the wall (claim 1).

Clearly, Pasch et al. and Dausch are deficient as references because an entire structural element, the layer of cellular foam, is not present. There is clearly no teaching and no suggestion of utilizing a foam material to mount the duct (13) of Pasch et al. or duct (3) of Dausch within their respective cross member portions (4) or the transverse support (3), respectively. Recognizing this, the Examiner relies on a host of secondary references.

In each of the secondary references, Wycech '526, Emmelmann et al. '542, Schoen et al. '933,

Hopton et al. '940, Czaplicki '457 and Czaplicki et al. 723; an internal tube disclosed as is only used to reinforce an outer beam. In none of these references is the internal tube, a duct having openings aligned with openings through a frame member or a pillar. Using an inner hollow member as a duct within the recited frame member of claim 6 or within the recited pillar of claim 1 is not taught or suggested as desirably by the primary or secondary references. Consequently, there is no suggestion in the references and motivation for the combination comes only from Applicants' disclosure.

As is set forth in In re Fulton 04-1267:

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998). Stated another way, the prior art as a whole must "suggest the desirability" of the combination. In re Beattle, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (internal quotation omitted); Winner Int'l Royalty Corp. v. Wang 202 F.3d 1340 (Fed. Cir 2000) (Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." (emphasis added). The source of the teaching, suggestion, or motivation may be "the nature of the problem," "the teachings of the pertinent references," or "the ordinary knowledge of those skilled in the art." In re Rouffet, 149 F.3d at 1355.

That the motivation comes only from Applicants' disclosure is evident from Omarain '767 applied against independent claim 1 and dependent claims 7 and 2-5. Omarain discloses a load carrying post 1 with an air duct 4 within the post, yet having the reinforcing structure of prior art

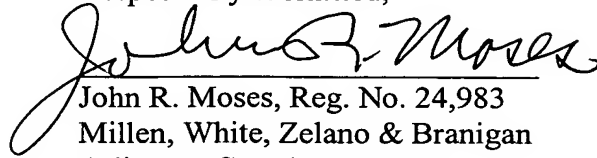
cited by the Examiner available to him, Omarain is silent as to how the duct is laterally supported within the pillar. Clearly, the only motivation to use expanded foam and/or expanded adhesive occurs in Applicant's disclosure not in the prior art. The references are therefore evidence of non-obviousness rather than evidence of obviousness. It is respectfully submitted that the combination of references has therefore failed to establish a *prima facie* case of obviousness and should be withdrawn because the prior art on a whole does not support the desirability of the combination.

With respect to Applicants new independent claim 19 and new dependent claims 20-23, Applicants are claiming the rear HVAC duct and pillar assembly disclosed in the last two sentences of paragraph [0029]. In claim new dependent 24, Applicants are reciting that the pillar of claim 1 is a "rear pillar."

In that this is a full and complete response to the Office Action of September 7, 2004, this application is now in condition for allowance. If the Examiner for any reason feels a personal conference with Applicants' attorneys might expedite prosecution of this application, the Examiner is respectfully requested to telephone the undersigned locally.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John R. Moses", is written over a horizontal line.

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In the Drawings:

Proposed Amendments to the drawings are attached hereto and shown in red for the Examiner's approval.